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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,784	03/19/2004	Rodney Scott Armentrout	71418/US02	7760

7590 08/17/2005

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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/804,784

Applicant(s)

ARMENTROUT ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 23-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1204, 704</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1711

Applicant's election with traverse of claims 1-22, the species of polyethylene glycol, hard segment polyesters and terephthalic acid end capping agent in Paper No. 6-7-05 is acknowledged. The traversal is on the ground(s) that it would be less burdensome on applicants in the Office for all claims to be searched and examined together. This is not found persuasive because as set out in the previous Office action, the search for the inventions are not co-extensive. Therefore undue burden of search would exist.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-13 are withdrawn from consideration as being drawn to a non-elected species while claims 23-42 are withdrawn from consideration as being drawn to a non-elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 14-22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative; under 35 U.S.C. 103(a) as obvious over McNamara et al. (USP 6,444,758).

McNamara et al. disclose a composition produced by end capping a polyethylene glycol/polyester block copolymer in situ with a fatty acid. Note Example 1 in this regard and that all reagents producing the product including the end capping reagent are introduced together. Since the fatty acid is acidic and is chemically combined as an end unit on the end of the block copolymer, the fatty acid reads on applicants' acid end capping reagent. Furthermore since the BMPA reagent which forms the polyester unit is also present in the polymer, this reagent also reads on applicants' end capping reagent. Note that the block copolymer has an acid number at column 22 line 41 and is therefore acidic. Note that the block copolymers may be blended with materials such as polyesters at column 21 lines 17-21. Since applicants' specification discloses that their hard block may be a polyester and since they block out one of the blocks of McNamara's polyester, it would reasonably appear that the polyester block of McNamara is a hard block. Note that the composition has an antistatic effect. See the Abstract in this regard. While arguably the acid end capping reagent of applicants as defined by applicants or at least as applicants intend to define them may necessarily introduce acidic units as an end unit. Note that the paragraph bridging columns 6 and 7 of the patent specifically disclose use of diacids and therefore acidic end unit moieties are contemplated by McNamara although admittedly there are no specific examples of such in the patent.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re

Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Arguably, the PMPA as utilized by patentees does not result in a block copolymer as contemplated by applicants. However as set out above, patentees clearly disclose the use of diacids at the paragraph bridging columns 6 and 7 of the patent for use as an acid end capping agent and also discloses the use of other acidic materials such as ascorbic acid as a mixture such as possibly contemplated by applicants' claims. Therefore use of such materials would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in the expectation of adequate results based on the disclosure of McNamara absent any showing of surprising or unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

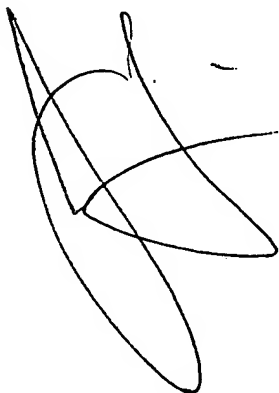
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Art Unit: 1711

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J. Mullis:cdc

August 13, 2005

**Jeffrey Mullis  
Primary Examiner  
Art Unit 1711**

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.